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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,545	01/20/2004	Hanspeter Schad	DT-6742	2853
30377	7590	07/12/2005	EXAMINER	
DAVID TOREN, ESQ. ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017-5621			NASH, BRIAN D	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/761,545

Applicant(s)

SCHAD, HANSPETER

Examiner

Brian Nash

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-6 is/are rejected.
 7) ☒ Claim(s) 7-11 is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) ☐ Notice of Informal Patent Application (PTO-152)
 6) ☐ Other: _____.

DETAILED ACTION

Examiner's Comments

1. This action is in response to applicant's amendment received 4/25/2005. Applicant has amended the abstract and claims 3, 5-6 and 8. Applicant's amendments have remedied the objections to the specifications and the rejections made under 35 USC 112 first and second paragraphs.
2. Regarding claim 8 and as noted in the first office action mailed 2/4/2005, the specifications disclose that DE 19830415 (hereinafter DE '415) has a voltage pulse generating mechanism that is automatically triggered when an impact force is detected at the piezo element. Applicant has stated in the remarks received 4/25/2005 that the counter (12) merely counts the detected vibration peaks of the piezo actor before the next pulse is generated. Therefore, DE '415 similarly "controls" the pulse generation by an obvious means.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 19830415 (hereinafter DE '415). DE '415 shows the same invention including a hand-held electrical tool having a striking means for generating impact forces on the anterior of the tool, a housing

Art Unit: 3721

enclosing the striking means, and a handle affixed thereon, wherein the striking means is formed as a high-energy piezo actor connected to a voltage pulse generating unit fixed to the tool housing. According to applicant's description in the specification on pages 4-5, DE '415 shows a hand-held electrical tool having rearward handle (21), a pulse striking mechanism (12,14) that drives a probe, i.e. a tool, along a striking axis and through the ground via a high-energy piezo element (see Figs. 1,2 of DE '415) via impact forces generated by the abrupt expansion of the voltage pulse generation on an anvil (14) which accelerates a spring-biased (18) piston (11) and then effects an impact force on the anvil via the piezo element.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE '415. As discussed above, DE '415 discloses the invention substantially as claimed, but does not show a handle connected to a vibration node of the tool housing or connected via a vibration damping means. While the specific location of the handle may be connected to a vibration node of the tool at rest, operation of the tool creates other vibration forces thereby changing the specific location of the vibration node. Therefore, it is reasonable to conclude that any handle connected to the tool is connected to a vibration node at some point during the operation of the tool.

Art Unit: 3721

Regarding the handle connected to the tool via a damping means, it is well known in the art to provide damping means to tools creating excessive vibration forces, especially hand-held tools that affect the operator. Additionally, applicant has pointed out that DE '415 creates strong housing vibrations which should preferably be subdued in electrical hand-held power tools, especially in the handle (see specifications, page 5, lines 7-9. Official Notice is taken that both the concept and the advantages of providing electrical hand-held power tools that generate excessive vibration forces with handles that are attached via damping means are well known in the art for the purpose of isolating the vibration from the operator. It would have been obvious to provide the hand-held tool of DE '415 with damping means for the handle in order to isolate the operator from excessive vibrations.

Regarding claim 6, it is noted (and confirmed by applicant's remarks) that hand-held power tools generate excessive vibration forces and that it would be routine, i.e. obvious to one having ordinary skill in the art to "tune" the resonance of such tools to within a range in order to minimize such vibration.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over DE '415 in view of US 6,286,610 to Berger et al. As discussed above in this office action, DE '415 discloses the invention substantially as claimed, but does not show a handle or handles configured as a main rear handle and second side handle. Berger et al teach the use of a first (16) and second (17) handle connected to a percussion hand-held tool for the purpose of reducing the vibrations acting on the hand or arm of the operator guiding the tool to an negligible amount. It would have been obvious to one skilled in the art to configure/modify the tool of DE '415 in order to incorporate a double handle for the purpose of reducing vibrations to the operator, since such a modification is

Art Unit: 3721

within the engineering purview of the skilled artisan concerned with reducing the vibration forces affecting a tool operator.

Allowable Subject Matter

8. Claims 7-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. *In re* claims 1 and 5, applicant's arguments filed 4/25/2005 have been fully considered but they are not persuasive. Applicant contends, *inter alia*, that DE '415 does not perform the same function as the claimed invention. Examiner acknowledges applicant's position; however, a reference is deemed to properly anticipate a claim when all the recited limitations are disclosed therein. In this instance, DE '415 clearly shows all the recited structural limitations including a an electrical tool having a striking means for generating impact forces, a rearward handle (21) affixed thereon, wherein the striking means is formed as a high-energy piezo actor per applicant's description in the specification on pages 4-5.

While it is noted that the device of DE '415 does not show the same handle as applicant's invention, it is deemed that the claims are not restrictive to such device.

Similarly and as noted in the prior office action, "spring means" as stated in claim 5 has been construed to define any spring.

Regarding claims 2-4, applicant contends, *inter alia*, that a prima facie case of obviousness has not been met. Specifically that it would not have been obvious for one having

Art Unit: 3721

ordinary skill in the art to utilize the well known concept and advantage of providing hand-held power tools that generate excessive vibration forces with handles that are attached via damping means for the purpose of isolating and/or minimizing the vibration from the operator. Examiner acknowledges applicant's position; however, a reference and/or references is/are deemed to properly obviate a claim when the prior art reference (or references when combined) teach or suggest all the claim limitations.

Additionally, applicant has not challenged the taking of Official Notice to this fact and it is therefore held that the well-known concept of providing electrical hand-held power tools that generate excessive vibration forces with handles that are attached via damping means for the purpose of isolating the vibration from the operator is admitted prior art.

For the reasons above, the grounds for rejection are deemed proper.

Art Unit: 3721

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467.

The official fax number for this Group is: 703-872-9306

Brian Nash
7 July 2005



**SCOTT A. SMITH
PRIMARY EXAMINER**